ureidopropionate compound, or a derivative, analog, or a pharmaceutically acceptable salt thereof.

D1

Claim 90. (Previously presented) The method of claim 89, wherein said uracil is a derivative selected from the group consisting of substituted pyrimidines, UMP and uridine, or analogs thereof.

REMARKS

Claims 68-90 are pending in the instant application. Claim 88 has been amended. Accordingly, claims 68-90 will remain pending in the application.

Support for the amendment of claim 88 can be found in the pending claim 88 (*i.e.*, prior to the amendment presented herein), Figure 1, and throughout the specification as originally filed, at least, for example, at page 20, line 29 through page 23, line 12, and page 30 line 15 through page 31 line 26. *No new matter has been added.*

Amendment and/or cancellation of the claims are not to be construed as acquiescence to any of the objections/rejections set forth in the instant Office Action or any previous Office Action, and were done solely to expedite prosecution of the application. Applicants submit that claims that were not added or amended during the prosecution of the instant application for reasons related to patentability. Applicants reserve the right to pursue the claims as originally filed, or similar claims, in this or one or more subsequent patent applications.

Claim Rejections - 35 U.S.C. §102

Rejection of Claims 88-90 under 35 U.S.C. §102(b)

Claims 88-90 are rejected under 35 U.S.C. §102(b) as anticipated by El Nasser Ossman *et al.*, Chem. Abstract 107:168619. In particular, the Office Action states that the reference discloses that 2,4-quinazolindione compounds have anticonvulsant activity against convulsions. The Office

Action further states that the instant claims read on the reference disclosed therapeutic effect because the instant claims are drawn to administration of reference disclosed compounds to achieve the same therapeutic effect.

Applicants respectfully traverse this rejection. However, without acquiescing to the rejection and in order to expedite prosecution, claim 88 has been amended such that claim 88 no longer reads on the five (5) compounds disclosed in El Nasser Ossman *et al.*

Support for the amendment to claim 88 can be found in Figure 1 and in the disclosure of page 20, line 29 through page 23, line 12, and page 30 line 15 through page 31 line 26 of the instant specification, which describes the compound genus of claim 88 (and all of the possible substituents associated therewith), methods of preparation of such compounds and applicability to the methods of the invention.

Moreover, the present amendment to claim 88 is clearly permitted under *In re Johnson*, which states that an applicant is permitted to narrow the scope of pending claims by merely excising the invention of another to which the applicant is not entitled. *In re Johnson*, 558 F.2d 1008, 1019 (C.C.P.A. 1977). To hold otherwise would "let form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed." *Id.* at 1018. In *Johnson*, the C.C.P.A. permitted a patent applicant to enter a proviso to the claims in order to overcome a prior art rejection, even though that proviso did not have *ipsis verbis* support in the specification. *Id. at 1013.* Furthermore, the Court indicated that "[i]t is for the inventor to decide what *bounds* of protection he will seek." [*Id.* at 1018; emphasis in original.] Accordingly, the court held that "[w]e are convinced that the invention recited in [the] claim ... [of interest] ... is 'disclosed in the manner provided by the first paragraph of Section 112' ". *Id.* at 1017.

Applicants submit that amended claim 88, and claims 89 and 90 (*i.e.*, by virtue of their dependency on claim 88) no longer read on the compounds disclosed in the El Nasser Ossman *et al.* reference. As such, the amendments to claim 88 have rendered moot the rejection of claims 88-90 under 35 U.S.C. §102(b). Applicants therefore, respectfully request reconsideration and withdrawal of the rejection.

Provisional Rejection of Claim:

Judicially Created Doctrine of Obviousness-Type Double Patenting

Provisional Rejection of Claim 68-90 under Judicially Created Doctrine of Obviousness-Type Double Patenting

Claims 68-90 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 68, 138 and 143-153 of copending Application No. 09/932,677. In this regard, Applicants will address the obviousness-type double patenting rejection upon a finding that the claims are in condition for allowance but for the obviousness-type double patenting rejection.

CONCLUSION

In view of the foregoing, entry of the amendments and remarks presented, favorable reconsideration and withdrawal of the rejections, and allowance of this application with all pending claims are respectfully requested. If a telephone conversation with Applicants' attorney would expedite prosecution of the above-identified application, the Examiner is invited to call the undersigned at (617) 227-7400.

Respectfully submitted,

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